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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,158	11/15/2001	Jeffrey D. Kenyon	020366-086100US	3861
20350	7590	04/19/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			POND, ROBERT M	
		ART UNIT	PAPER NUMBER	
		3625		

DATE MAILED: 04/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/991,158	KENYON, JEFFREY D.
	Examiner Robert M. Pond	Art Unit 3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 20 December 2004.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 2,4,6-12 and 22-25 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 2,4,6-12, and 22-25 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

The Applicant amended Claims 2, 4, 8, 22, and 23, and newly added independent Claims 24 and 25. All pending claims (2, 4, 6-12, and 22-25) were examined in this final Office Action necessitated by amendment.

### ***Response to Arguments***

#### **Rejection under 35 USC 112 (Claim 22)**

The Applicant amended Claim 22. Rejection under 35 USC 112 is withdrawn.

#### **Rejection under 35 USC 102(e) and 103(a)**

Applicant's arguments filed 20 December 2004 have been fully considered but they are not persuasive.

- The items accessed by the consumer using the PDA contain information necessary to purchase goods.
- Covington teaches the PDA being connected to the computer systems using wireless connections. This provides a direct connection. Covington further discloses PDAs using a cradle interface to computers as previously cited- a direct connection.
- Covington discloses the use of the PDA at home location and at remote locations (see paragraph 0079).

- Regarding Claim 7, it appears the basis of the arguments is dependent upon arguments set forth for Claim 22.
- Regarding Claim 23, as noted above Covington discloses the a portable device being used at remote locations. Reed does not teach away. It provides a pertinent teaching of accessing a yellow pages directory full of information items.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. **Claims 2, 4, 6, 8-12, 22, 24, and 25 are rejected under 35 USC 102(e) as being anticipated by Covington et al. (Paper #20041018, patent application number 2003/0154135 hereinafter referred to as “Covington”).**

Covington teaches all the limitations of Claims 2, 4, 6, 8-12, 22, 24, and 25.

For example, Covington discloses an interactive system and method for shopping that separates the shopping process from the buying process.

Covington discloses a consumer using a computer remotely connected to online web merchants over the Internet, the consumer browsing and creating wish lists

and shopping cart lists and downloading these lists from the web sever to the remotely connected computer to the PDA or directly to the PDA (see at least abstract; Fig. 1 (10); pages 1-2, 0012-0016; page 13, 0149). Covington further discloses:

- *Accessing the information items at a website:* in-store, in-mall and online shopping using a web browser to navigate (see at least Fig. 1 (28, 32); page 4, 0066).
- *Searching a database:* web site includes a web server, database organized for rapid search and retrieval (see at least Fig. 1 (38); page 4, 0069).
- *Placing the information items in an information shopping cart at the website:* consumer selects products and places selected items into shopping cart; transfers wish list to shopping cart (see at least Fig. 11 (312, 410); Fig. 14 a-b; page 8, 0106; page 9, 0110-0111).
- *Transmitting the information shopping cart having the selected information items to a portable device:* server transmits scan lists, wish lists, shopping cart data directly to PDA via a wireless data connection; downloads via an interface cradle; retailer name displayed (please note examiner's interpretation: branding information); shopping portal domain name used to access web site (please note examiner's interpretation: necessary for any device used to transact purchases from shopping cart) (see at least Fig. 28; page 4, 0068; page 13, 0149; page 15, 0166).

- Naming information: consumer names wish lists and transfers named wish lists to PDA as noted above (see at least page 9, 0110; page 16, 0175).
- Directory: provides a directory (see at least page 4, 0069)
- Languages and protocols: HTML, Java, XML, JavaScript, SHTML (see at least page 4, 0069).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**2. Claim 7 is rejected under 35 USC 103(a) as being unpatentable over Covington (Paper #20041018, patent application number 2003/0154135), in view of Communications Today (Paper # 2, PTO-892, Item: U hereinafter referred to as “CT”).**

Covington teaches all the above as noted under the 102(e) rejection and teaches a) consumer viewing transmitted information from the web site using various formats, and b) consumers using a PDA to interact with a web shopping service, but does not disclose the user selecting the format. CT teaches a wireless Internet service that allows users to choose from four display screen formats as their starting point for browsing the wireless Web (U: see at least

page 1). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Covington to allow consumers to select a screen format as taught by CT, in order to accommodate consumer preferences, and thereby attract consumers to the commerce service.

**3. Claim 23 is rejected under 35 USC 103(a) as being unpatentable over Covington (Paper #20041018, patent application number 2003/0154135), in view of Reed et al. (Paper #20041018, patent number 5,862,325 hereinafter referred to as “Reed”).**

Covington teaches an interactive system and method for shopping that separates the shopping process from the buying process. Covington teaches a consumer using a computer remotely connected to online web merchants over the Internet, the consumer browsing and creating wish lists and shopping cart lists and downloading these lists from the web sever to the remotely connected computer to the PDA or directly to the PDA (see at least abstract; Fig. 1 (10); pages 1-2, 0012-0016; page 13, 0149). Covington further teaches:

- Accessing the information items at a website: in-store, in-mall and online shopping using a web browser to navigate (see at least Fig. 1 (28, 32); page 4, 0066).
- Searching a database: web site includes a web server, database organized for rapid search and retrieval (see at least Fig. 1 (38); page 4, 0069).

- *Placing the information items in an information shopping cart at the website:* consumer selects products and places selected items into shopping cart; transfers wish list to shopping cart (see at least Fig. 11 (312, 410); Fig. 14 a-b; page 8, 0106; page 9, 0110-0111).
- *Transmitting the information shopping cart having the selected information items to a portable device:* server transmits scan lists, wish lists, shopping cart data directly to PDA via a wireless data connection; downloads via an interface cradle; retailer name displayed (please note examiner's interpretation: branding information); shopping portal domain name used to access web site (please note examiner's interpretation: necessary for any device used to transact purchases from shopping cart) (see at least Fig. 28; page 4, 0068; page 13, 0149; page 15, 0166).
- *Naming information:* consumer names wish lists and transfers named wish lists to PDA as noted above (see at least page 9, 0110; page 16, 0175).
- *Directory:* provides a directory (see at least page 4, 0069)
- *Languages and protocols:* HTML, Java, XML, JavaScript, SHTML (see at least page 4, 0069).

Covington teaches all the above as noted under the 103(a) rejection and teaches a) communicating information to consumers, and b) providing directory service and indexes but does not disclose a yellow pages directory. Reed teaches transferring data, metadata, and method from a provider computer to a

consumer computer. Reed further teaches a yellow pages directory service used to classify and represent a large database of objects communicated to consumers (see at abstract; least col. 98, lines 62-67). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Covington to implement a yellow pages directory as taught by Reed, in order to classify and communicate a large database of objects to consumers, and thereby attract consumers to the service.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 571-272-6760. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert M. Pond  
Primary Examiner  
April 14, 2005